

REMARKS:

Applicants have studied the Office Action dated December 8, 1999 and have made amendments to the claims. Applicants respectfully request entry of this amendment pursuant to 37 C.F.R. § 1.116 in that the amendment and remarks below place the application and claims in condition for allowance or, at least, present the application in better form for appeal. It is submitted that the application, as amended, is in condition for allowance. Upon entry of this amendment, claims 17-21 are pending. Claim 17 is requested to be amended. Reconsideration and reexamination are respectfully requested.

Applicants believe the foregoing amendments comply with requirements of form and thus may be admitted under 37 C.F.R. § 1.116(a). Alternatively, if these amendments are deemed to touch the merits, admission is requested under 37 C.F.R. § 1.116(b). In this connection, these amendments were not earlier presented because they are in response to the matters pointed out for the first time in the Final Office Action. Lastly, admission is requested under 37 C.F.R. § 1.116(a) as presenting rejected claims in better form for consideration on appeal.

The changes made to the specification (page 9, line 13) by the Amendment dated September 23, 1999 was objected to as containing new matter. The changes are now canceled.

Claim 17 was rejected as being anticipated by Setsune (JP 61-121042). This rejection is respectfully traversed.

Claim 17 requires a sapphire tool having a sharp edge formed by a working plane and a cleavage plane parallel to the plane R. To more clearly define the subject matter of the invention, this claim is amended to require that the angle between the working plane and the cleavage plane be less than about 70 degrees. As described in the specification, the angle between the working plane and the R plane is 57.615° (page 14, first full paragraph), and the orientation of the cleavage plane may have an error of $\pm 10^\circ$ from the plane R. The Setsune reference does not teach or suggest this limitation. The sapphire crystal there is used as a part of an optical waveguide, and the cleavage plane parallel to the plane R are used as the input-side and output-side end faces of the waveguide. The end faces appear to be perpendicular to the longitudinal surfaces of the waveguide, which might have been required to reduce loss in signal coupling. Therefore, Setsune does not teach or suggest the amended claim 17, and claim 17 is patentable over Setsune.

Claims 18-21 were rejected as being anticipated by Morita et al. (U.S. Pat. No. 5,753,966). In a previous response (September 23, 1999) to the first Office Action, the applicants sought to remove the Morita patent as prior art by relying on the foreign priority date of the present application. The Final Office Action now required that English translations of the Japanese-language priority documents be filed. In response, such a translation is submitted as attached hereto. Accordingly, the applicants respectfully submit that the Morita reference does not qualify as prior art against claims 18-21, and these claims are therefore allowable.

The preceding amendments and remarks are made in accordance with 37 C.F.R. §1.116. The amendments to the claims are believed necessary to conform with the requirements made by the Examiner in the final Office Action of December 8, 1999. As these requirements were raised in the final Office Action, the applicants did not have an opportunity to present these amendments earlier.

Applicants respectfully submit that the amendments presented herein add no new limitations that were not previously presented and that no additional search is required. These amendments are made to present the rejected claims to place them in condition for allowance. Accordingly, applicants respectfully request that this amendment after final rejection be entered and a notice of allowance be issued.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (310) 282-2000 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

LOEB & LOEB LLP

By:


John P. Scherlacher

Registration No. 23,009

Attorney for Applicant(s)

Date: March 6, 2000

10100 Santa Monica Blvd., 22nd Floor
Los Angeles, California 90067-4164
Telephone: 310-282-2000
Facsimile: 310-282-2192